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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,877	03/29/2001	Scott Wolinsky	IT/01	7170

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EXAMINER

JONES, SCOTT E

ART UNIT PAPER NUMBER

3713

DATE MAILED: 04/21/2004

*23*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/823,877

Applicant(s)

WOLINSKY, SCOTT

Examiner

Scott E. Jones

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 December 2003 and 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 and 60-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 and 60-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/26/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3713

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment and request for continued examination filed on December 26, 2003 and the supplemental amendment filed on January 30, 2004 in which applicant amends claims 1, 16, 17, and 19, submits formal replacement drawings, and responds to the claim rejections. Claims 1-40 and 60-67 are pending.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 26, 2003 has been entered.

### ***Drawings***

3. The drawings were received on December 26, 2003. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 7-10, 16-19, 25-28, and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman (U.S. 5,558,339).

Perlman discloses an apparatus and method for linking multiple remote players of real-time games over a traditional telephone line. Perlman accomplishes this goal by having prospective players dial into a server which determines, based on a telephone number and information provided

Art Unit: 3713

by a player, which players to connect to each other to play the game. Once this match is determined, both players are disconnected from the server, and one of the player's computers automatically dials the other player's phone number and establishes a direct connection via a traditional telephone line to play the game.

Perlman describes a player's phone number as an "address" or "network address" in a data network. However, due to privacy concerns, a player's phone number is not "explicitly" shown to the opposing player. Rather, a screen name or handle, and identification code is sent and displayed by both computers. Therefore, the examiner contends that the screen name, handle, and/or identification code are equivalent to a player's telephone number because each are used to identify a particular player (Figures 3, 4, and 8, Column 10, lines 18-35, and Column 11, lines 20-49).

Furthermore, players are able to communicate with each other via speakerphone during the game (Column 41, line 65-Column 42, line 56).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to use Perlman's apparatus and method to use a screen name and identification code to identify game players. One would be motivated to do so because of important privacy considerations.

Additionally, regarding claims 8, 17, 26, and 35, Perlman seems to lack explicitly disclosing one of the terminals is a wireless telephone, walkie-talkie, or wireless toy. However, to one having ordinary skill in the art at the time of applicant's invention, it would have been obvious to incorporate a wireless telephone, walkie-talkie, or wireless toy in Perlman's system. Doing so enables a player the mobility to play the game remotely from traditional landlines.

Art Unit: 3713

6. Claims 2-6, 11-15, 20-24, 29-33, and 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman (U.S. 5,558,339) in view of Teshima et al. (U.S. 5,273,288) and further in view of Golad (U.S. 6,231,441).

Perlman discloses that as discussed above regarding claims 1, 7-10, 16-19, 25-28, and 34-40.

Perlman seems to lack explicitly disclosing:

Regarding Claims 2, 11, 20, 29, and 63-64:

- defining a plurality of identifiers used to differentiate between the first and second players;
- activating a first indicator representing the first player;
- activating a second indicator representing the second player;
- indicating at each terminal whose turn it is;
- receiving the instruction from the player whose turn it is;
- and displaying at each terminal the game move and identifier.

Regarding Claims 3, 12, 21, and 30:

- the game move and identifier are displayed on one or more keys of a keypad used to dial the dialed telephone number.

Regarding Claims 4, 13, 22, and 31:

- the received input instruction comprises at least one dual tone multi-frequency (DTMF) signal.

Regarding Claims 5, 14, 23, and 32:

- the player whose turn it is indicated by sequentially activating and deactivating one of the first and second indicators at each of the terminals.

Regarding Claims 6, 15, 24, and 33:

Art Unit: 3713

- the first and second indicators comprise color coded LEDs.

However, Teshima et al., like Perlman teaches of a game played over a telephone line. In particular, Teshima et al. teaches a communication terminal connected to a telephone line for playing a game with an opponent having the same game connected through a telephone line wherein game moves are shown on the key pad/grid used to dial telephone numbers (Abstract, Figure 4, Column 1, lines 8-12, 25-30, and Column 3, lines 10-21).

Golad (U.S. 6,231,441) teaches of a game board controlled by a computer/software that can be used for various games and is played by a plurality of players. Golad lacks explicitly disclosing that the games board can be played over a phone line. However, Golad teaches:

Regarding Claims 2, 11, 20, 29, and 63-64:

- defining a plurality of identifiers used to differentiate between the first and second players (Figure 1, Column 1, line 4-Column 2, line 5, Column 2, line 59-Column 3, line 3, and Column 3, lines 35-43);
- activating a first indicator representing the first player (Figure 1, Column 1, line 4-Column 2, line 5, Column 2, line 59-Column 3, line 3, and Column 3, lines 35-43);
- activating a second indicator representing the second player (Figure 1, Column 1, line 4-Column 2, line 5, Column 2, line 59-Column 3, line 3, and Column 3, lines 35-43);
- indicating at each terminal whose turn it is (Figure 1, Column 1, line 4-Column 2, line 5, Column 2, line 59-Column 3, line 3, and Column 3, lines 35-43);
- receiving the instruction from the player whose turn it is (Figure 1, Column 1, line 4-Column 2, line 5, Column 2, line 59-Column 3, line 3, and Column 3, lines 35-43);

Art Unit: 3713

- and displaying at each terminal the game move and identifier (Figure 1, Column 1, line 4-Column 2, line 5, Column 2, line 59-Column 3, line 3, and Column 3, lines 35-43).

Regarding Claims 3, 12, 21, and 30:

- the game move and identifier are displayed on one or more keys of a keypad used to dial the dialed telephone number (Figure 1, Column 1, line 4-Column 2, line 5, Column 2, line 59-Column 3, line 3, and Column 3, lines 35-43).

Regarding Claims 5, 14, 23, and 32:

- the player whose turn it is indicated by sequentially activating and deactivating one of the first and second indicators at each of the terminals (Figure 1, Column 1, line 4-Column 2, line 5, Column 2, line 59-Column 3, line 3, and Column 3, lines 35-43).

Regarding Claims 6, 15, 24, and 33:

- the first and second indicators comprise color coded LEDs (Figure 1, Column 1, line 4-Column 2, line 5, Column 2, line 59-Column 3, line 3, and Column 3, lines 35-43).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the game features of Teshima et al. in Perlman's game communication system. One would be motivated to do so because a player may not have access to a personal computer at all times.

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the features of Golad in the combination of Perlman in view of Teshima et al. Doing so enables players to easily differentiate between each player's game moves.

Art Unit: 3713

Furthermore, regarding claims 4, 13, 22, and 31, it would have been obvious to utilize (DTMF) signals in phone system keypads. Doing so would provide standard technology available for digital phones that was notoriously well known at the time of the applicant's invention.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 60-62 and 65-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,682,427. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious at the time of applicant's invention to obtain telephone number information from a game player's telephone via a caller ID system to be displayed on the game screen. Obtaining caller ID information from a caller is notoriously well known.



*Response to Arguments*

9. Applicant's arguments filed December 26, 2003 and January 30, 2004 have been fully considered but they are not persuasive.

10. At the onset, it is noted that applicant has made a request for the examiner to initiate a personal interview prior to issue of a first Office Action in the continued examination. While it is noted that examiner initiated interviews, as proscribed in practice by the MPEP, are generally limited to such issues as requests for restriction, or minor claim changes at allowance and that it is not considered general practice for an examiner to initiate an interview otherwise, applicant's request is noted. If applicant would like to interview the pending application, he is welcomed to contact the examiner and such will be readily accommodated. However, as a matter of personal practice and time management, the instant examiner does not initiate interviews when the record, as in this application, is clear as to the position adopted by the examiner.

11. Applicant's arguments, see page 2 and the drawing replacement sheets, filed December 26, 2003, with respect to the objection to the drawings has been fully considered and is persuasive. The objection of the drawings has been withdrawn.

12. Applicant traverses the rejection to claims 1, 7-10, 16-19, 25-28, and 34-40 under 35 U.S.C. 103(a) as being unpatentable over Perlman (U.S. 5,558,339). Applicant alleges the prior art fails to teach or suggest, "each of two communication terminals accesses its own telephone number from one memory location and the other terminal's telephone number from another memory location, and displays both telephone numbers at the same time." The examiner respectfully disagrees. As previously discussed in previous Office Action, Paper No. 7, Perlman describes a player's phone number as an "address" or "network address" in a data network. However, due to privacy concerns, a player's phone number is not "explicitly" shown to the opposing player. Rather, a screen name or

Art Unit: 3713

handle, and identification code is sent and displayed by both computers. Therefore, the examiner contends that the screen name, handle, and/or identification code are equivalent to a player's telephone number because each are used to identify a particular player (Figures 3, 4, and 8, Column 10, lines 18-35, and Column 11, lines 20-49). Therefore, the examiner maintains Perlman renders the claims obvious.

13. Applicant traverses the rejection to claims 1, 7-10, 16-19, 25-28, and 34-40 under 35 U.S.C. 103(a) as being unpatentable over Perlman (U.S. 5,558,339). Applicant alleges the prior art fails to teach or suggest, the speakerphone limitation present in claims 7, 16, 25, and 34. Applicant alleges Perlman does not affirmatively teach this limitation. The examiner respectfully disagrees. Perlman discloses speech communication between players, which can occur via a conference call, can be output through a loudspeaker (speakerphone), such as a home television's speaker (Column 41, line 31-Column 42, line 35). Therefore, the examiner maintains Perlman renders the claims obvious.

#### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones  
Examiner  
Art Unit 3713

A handwritten signature in black ink that reads "Scott E. Jones". The signature is written in a cursive style with a large, stylized "S" and "J".

sej